

REMARKS

The Examiner has objected to Claims 1-8 because said claims referred to both "consisting essentially of" and "comprising". Accordingly, Claims 1-8 have been amended to, in the case of claims 1-4, a silver colored, tarnish resistant, corrosion resistant alloy consisting essentially of 92-95 percent by weight silver, the balance of which is an alloy consisting essentially of a series of elements and a hardening agent consisting of, in the case of claim 1, copper and tin; in the case of claim 2, copper; in the case of claim 3, copper and tin; and in the case of claim 4, copper and tin, but in a different percentage than claim 3.

Claims 5 through 8 claim a silver colored tarnish resistant, corrosion resistant jewelry consisting essentially of the same silver alloy as described in claims 1 through 4 as described above, but with specific percentages of the alloy constituents.

Claim 17 claims a silver colored tarnish resistant, corrosion resistant alloy consisting essentially of 92-95% by weight silver, the balance of which is an alloy comprised of zinc, silicon and a hardening agent consisting of copper. Claim 18 and 19 depend from claim 17. Claim 20 describes the alloy as consisting essentially of silver, the balance of which is an alloy consisting essentially of zinc, silicon, and a hardening agent consisting of copper. Claims 21 and 22 depend from claim 20. Claim 23 claims an alloy consisting essentially of silver, the balance of which is an alloy consisting essentially of zinc, silicon, and a hardening agent consisting of copper in a different concentration than those previously claimed. Claim 24 depends from claim 23.

Accordingly, applicant respectfully submits that since the hardening agent has been amended to "consisting of" the specified elements, the scope of the claims is clear.

Claim 1-8 stand rejected under 35 USC 112 as failing to comply with the written description requirement. The Examiner stated that the claims contain subject matter which was not described in the specification. Applicant respectfully disagrees. The specification on page 2 in the summary of the invention states, "a small amount of copper provides hardness". This may be found in paragraph 6 of the application. Also, on page 3, paragraph 10, the specification states, "the copper and tin or indium act as hardeners". Accordingly, applicant respectfully submits that the specification as filed specifically states that copper, or tin, or indium may be used as hardeners and the claims are so limited. No further hardeners are disclosed and to limit the claims in such a way is entirely within the scope of the disclosure.

Claims 1-8 stand rejected under 35 USC 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner has stated that it is unclear which elements are excluded by the presently claimed categories of hardening elements; as well as blending elements. Accordingly, the present claims are limited to alloys having either copper, indium or tin as hardening elements. All other hardening elements are excluded by use of the term, "consisting of". The use of the term "hardening element" is commonly known in the art. A dictionary definition from an appropriate technical source can be provided, if required. Examples of hardening elements that are excluded are germanium and boron, such as those claimed in the Bernhard and Eccles references cited by the Examiner.

Claims 17 through 24 stand rejected under 35 USC 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner has indicated that use of the terms "consisting essentially of", "comprised of", and "consisting of" is unclear. Accordingly, the Examiner has suggested amending claim 17 to delete the words "comprising" and include instead "consisting essentially of" in describing the elements found after silver, and in limiting the hardening agent to "consisting of 60-74% by weight copper". Accordingly, claims 17 - 24 have been so amended.

Claims 17 through 25 stand rejected under 35 USC 103 as unpatentable over Eccles or Bernhard. This rejection is respectfully traversed. The Examiner has indicated that the patents of Eccles or Bernhard disclose a silver based alloy that overlaps the instant net alloying ranges. However, Bernhard teaches the addition of boron, and Eccles teaches the addition of germanium. Both the Bernhard and the Eccles references specifically teach the requirement for boron or germanium for hardening. This is directly contrary to the present invention in which these hardening agents are specifically excluded. The Examiner has indicated that the limitation without further hardening elements and blending elements constitutes new matter. However, as noted above, the specific limitation of the hardening elements consisting of copper, tin or indium is specifically stated in the specification as filed. In addition, the Examiner states that if the applicant intended claim language to be "consisting essentially of" and the hardening element consists only of copper, then the prior art of Eccles would be overcome due to the presence of germanium, which is clearly taught by Eccles to be a hardening element. In view of the amendment to the claims, and the fact that Eccles and Bernhard teach the

requirement for germanium and/or boron, applicant respectfully submits that the present claims 1-8, and 17-24, as amended, are in a condition for allowance.

The Examiner has further indicated that she believes she has created a *prima facie* case of obviousness, and to overcome this presumption applicant must submit test data showing superior performance proprieties of applicant's compounds. To the contrary, the Bernhard and Eccles references require the presence of either boron or germanium for hardness. Applicant's compounds, as indicated in the summary of this invention, indicate the resultant alloy has improved corrosion resistance and improved tarnish resistance at a relatively low cost. Further, applicant has indicated that the applicant's alloys have improved tarnish resistance and casting qualities to make jewelry, dental fillings, and utensils. Accordingly, applicant respectfully submits that these alloys are equal in quality to that of Bernhard or Eccles without the use of additional hardeners such as boron or germanium. Since Bernhard and Eccles require the use of boron or germanium, a *prima facie* case of non-obviousness is shown.

Accordingly, reconsideration and allowance are respectfully requested.

Dated:

Respectfully submitted,

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